

REMARKS

[0001] In the Office Action, claims 1-48 are pending in the case. The Examiner objected to Claim 16 for informalities. Claim 16 has been amended to address the informalities. The Examiner rejected Claims 1-47 under 35 U.S.C. §112, 2nd paragraph for indefiniteness. The Examiner rejected Claims 1-16, 19-35, 38-45, and 48 under 35 U.S.C. §103(a) in view of what the Examiner asserts is Applicant's Admitted Prior Art in view of U.S. Patent No. 5,758,333 to Bauer et al. (hereinafter "Bauer"). The Examiner allowed Claims 17-18, 36-37, and 46-47 if amendments are made to overcome the rejections to the respective independent claims. In view of the amendments and following remarks, reconsideration and allowance of claims 1-48 is respectfully requested. Applicant has amended Claims 1, 9, 10, 13, 14, 16, 17, 20, 33, 36, 38, 43, and 46 to clarify the invention.

REJECTION OF CLAIMS 1-47 UNDER 35 U.S.C. 112, 2nd PARAGRAPH

[0002] The Examiner rejected Claims 1-47 under 35 U.S.C. §112, 2nd paragraph for indefiniteness. Applicant has amended Claims 1, 13, 14, 17, 20, 33, 36, 38, 43, and 46 to make the claims more definite. Specifically, the adjective "actual" was removed from "actual PCB" to clarify that a PCB is intended. Therefore, as the amended claims now explicitly refer to a PCB rather than to an actual PCB, the amended Claims 1, 13, 14, 17, 20, 33, 36, 38, 43, and 46 and dependents thereof are sufficiently definite under 35 U.S.C. §112, 2nd paragraph.

REJECTION OF CLAIMS 1-16, 19-35, 38-45, AND 48 UNDER 35 U.S.C. §103(a)

[0003] The Examiner rejected Claims 1-16, 19-35, 38-45, and 48 under 35 U.S.C. §103(a) in view of what the Examiner asserts is Applicant's Admitted Prior Art in view of Bauer. Applicant respectfully traverses this rejection.

[0004] Under 35 U.S.C. §103 the Examiner has the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the combination of the prior art references must teach or suggest all the claim limitations. MPEP § 2142.

[0005] Applicant asserts that a *prima facie* case of obviousness has not been made because what the Examiner asserts is Applicant's Admitted Prior Art (AAP) does not qualify as prior art. Use of admissions as prior art is controlled largely by case law. MPEP §2129 provides specific guidance for the Examiner on this matter. See MPEP §2129, Rev. 2 May 2004. In particular, if the specification "identifies work done by another as "prior art," the subject matter so identified is treated as admitted prior art." See MPEP §2129(II).

[0006] Applicant respectfully submits that what the Examiner asserts is Applicant's Admitted Prior Art (AAP) does not qualify as Admitted Prior Art. In the most recent Office Action mailed December 15, 2004, page 11, the Examiner asserts that Applicant has admitted prior art on page 6 at lines 5-7. That sentence states "Existing IMS constructs are utilized without predetermined knowledge of their number, type, language, order, or characteristics." Applicant asserts that this sentence is being improperly used out of context and does not qualify as admitted prior art.

[0007] The context for the sentence relied upon by the Examiner is defined by the position of the sentence in the specification, its position within a paragraph, and the context communicated by other sentences in the paragraph. First, the sentence is in the "Summary of the Invention" section of the patent application. Applicant respectfully asserts that such subject matter is clearly not a reference to work done by others that can be characterized as an admission

usable as prior art. Instead, subject matter in the "Summary of the Invention" section summarizes what the Applicant considers his invention, his own work. The heading "Summary of the Invention" provides context for the content of that section including the sentence relied upon by the Examiner.

[0008] Second, the sentence is the second of three sentences of a paragraph beginning on page 6 line 4 and continuing to line 10. Read as a whole the paragraph communicates a context relating to the benefits and advantages of the Applicant's invention. Similarly, the sentence the Examiner relies upon also relates to the benefits and advantages of the Applicant's invention.

[0009] Third, the first and second sentences both use the term "present invention." Therefore, since paragraphs group like ideas, the middle sentence relates to the present invention. While the second sentence does not use the term "present invention" the context clearly indicates that the second sentence relates to the present invention and not to utilization of existing IMS constructs by the prior art. In fact, reading sentences two and three together communicates the idea that the second sentence highlights one advantage of the present invention and the third sentence simply restates the benefit of the present invention. In particular, the present invention uses information from IMS constructs in their present or existing form. The present invention uses the IMS constructs without foreknowledge regarding the characteristics.

[0010] Therefore, neither the specific sentence relied upon by the Examiner in the last Office Action or the subject matter on page 6 lines 4-10 qualify as admitted prior art. The sentence relied upon the Examiner is taken out of context improperly. Use of the sentence out of context is contrary to the guidance provided in the MPEP §2129 (II) which specifically qualifies identification of subject matter in the specification as prior art with the requirement that "the

specification identifies work done by another as "prior art". Applicant has done nothing to identify the sentence relied upon by the Examiner as work done by another. Applicant respectfully requests that all rejections based upon this alleged admitted prior art be withdrawn.

[0011] The Examiner relies largely on the alleged AAP in rejecting Claim 1. As indicated, this subject matter is not prior art. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

[0012] "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP §2142. Further discussion of obviousness or evidence is moot in view of the fact that the Examiner has not established a *prima facie* case.

[0013] Nevertheless, for purposes of appeal, the Applicant would like to reiterate that "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP §2143.03. Each of the claim terms are to be given their reasonable meaning. The terms "IMS" and "PCB" were purposefully selected by the Applicant. Applicant finds no reference to "PCB" or "IMS" in Bauer. IMS is a well know hierarchical database management product available from IBM. Those of skill in the art readily recognize that the claimed invention relates specifically to IMS. There is no teaching or suggestion in Bauer regarding locating of a PCB for an IMS resource.

[0014] As explained in the specification, the ability to selectively locate and/or access multiple sets of PCBs saves considerable costs in terms of time and development work. See

Specification Page 6, lines 15-19. The present invention does not require any information about the IMS construct forms.

[0015] For the reasons stated above, Applicants respectfully submit that independent Claims 1, 19, 20, and 38 are patentably distinct from the cited reference. In addition, claims 2-18, 21-38, and 39-48 depend directly or indirectly from the independent claims. Accordingly, Applicants also respectfully submit that these dependent claims are likewise allowable for at least the same reasons.

[0016] In view of the foregoing, Applicant submits that the application is in condition for immediate allowance. In the event any questions remain, the Examiner is respectfully requested to initiate a telephone conference with the undersigned.

Respectfully submitted,



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